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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1948.

Nos. 163-164.

EDWARD J. MILLER, d/b/a PERMA-STONE COMPANY,
Petitioner,

v.

EMIL P. ZAHARIAS, CHESTER POLANIS, d/b/a LINCOLN HOME BUILDERS, BERNHARD WALLACE, JACK CASTRONOVO, ALBERT SALOMON, JANET SALOMON and MAXON W. POLLAND,
Respondents.

BRIEF FOR RESPONDENTS,

Emil P. Zaharias, Chester Polanis, d/b/a Lincoln Home Builders, and Bernhard Wallace,

OPPOSING APPLICATION FOR WRIT OF CERTIORARI.

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OPINION BELOW.

The opinion of the Circuit Court of Appeals (R. 341) is reported at 168 F. (2d) 1, and the opinion of the District Court (R. 235) is reported in 72 F. Supp. 29.

JURISDICTION.

The judgment of the Circuit Court of Appeals was entered May 7, 1948 (R. 346), and a petition for rehearing was filed on May 20, 1948 (R. 346), denied on June 15, 1948 (R. 347). The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925 [28 U. S. C. A., Par. 347 (a)].

Petitioner has not advanced any valid reason for granting the writ. The District Court in its opinion (R. 235), held the challenged claims 3, 4, 6, and 7 of U. S. Letters Patent No. 1,888,234, invalid and claims 1, 2, and 5 of Patent No. 1,960,276 valid and infringed, but that petitioner was barred from maintaining his action because of unclean hands.

The Court of Appeals for the Seventh Circuit affirmed the District Court in its opinion (R. 341) as to the holding of invalidity of Patent No. 1,888,234, reversed the District Court and found that the claims of Patent No. 1,960,276 did not constitute invention and were invalid, and acquiesced in the judgment dismissing the complaint for unclean hands by not passing upon that point.

The opinion of the Circuit Court of Appeals thus left the judgment of the District Court dismissing the complaint for want of equity, undisturbed. Under the caption "Questions Presented", the petition for certiorari submits two questions. One deals with the holding of functionality as to the claims of the method patent No. 1,888,234, and the other deals with the rule that one of two copending applications to the same inventor cannot be used to anticipate the other, in reference to patent No. 1,960,276.

SUMMARY OF ARGUMENT.

The Index above under "Argument" contains 7 subdivisions which are in effect a summary of the argument hereinafter appearing. For that reason, no further "summary of argument" is given.

1. The Questions Presented by Petitioner Are Now Moot.

Petitioner for a writ has presented two questions in his petition for a writ. One deals with the holding of functionality of the claims of the earlier patent, and the other deals in respect of the later patent, with the rule which obtains between copending applications of the same inventor. (Page 6 of the petition.) Petitioner has not presented any question upon the principal and most important reason for dismissal of his complaint in the trial court, i. e., the application of the unclean hands doctrine to his conduct. The court of appeals did not disturb the ruling in this respect but also ruled invalid all claims of the corner mold patent. Consideration of the case in this court would necessarily be limited to the questions specifically brought forward by the petition as was so clearly pointed out in General Talking Pictures Corporation v. Western Electric Company, Inc., et al., 304 U. S. 175, 546 at 177 and 179, 58 S. Ct. 849 at 851, wherein this appears:

> (177) "Our consideration of the case will be limited to the questions specifically brought forward by the petition . . . (179) One having obtained a writ of certiorari to review specified questions is not entitled here to obtain decision on any other issue. (Citing cases) . . . Petitioner is not here entitled to decision on any question other than those formally presented by its petition for the writ." (Interpolations supplied.)

To the same effect, see Dickinson Industrial Site, Inc., v. Cowan et al., 309 U. S. 382, 60 S. Ct. 595, 84 L. Ed. 819,

and Washington, Virginia & Maryland Coach Co. v. National Labor Relations Board, 301 U. S. 142, 57 S. Ct. 648.

Petitioner raised on appeal, the question of the trial court's finding that he was using his patents in suit as the effective means of restraining competition in the sale of unpatented coloring matter in paragraph numbered "4" of his Statement of Points Relied Upon on Appeal (R. 250). That question was decided adversely to petitioner by affirmance of that part of the judgment by the Circuit Court of Appeals and has not again been presented here.

Should petitioner prevail upon either or both of his questions herein presented, there still could be no reversal of the judgment inasmuch as the principal reason for dismissal of the complaint, i. e., the finding that plaintiff's conduct estopped him from any relief in this action, could not be reached in this court. The questions now presented being moot, and assuming (but not conceding) that they were resolved for petitioner, that could still have no practical effect upon the case. See Wisconsin E. R. Board v. Allis Chalmers W. Union, 252 Wisconsin 436, at 441, 32 N. W. (2d) 190.

2. **There Is No Conflict of Decisions Between Different Circuit Courts of Appeals.**

The conflict must be between decisions on the same case. There is no allegation in the petition for a writ that the decision of the Circuit Court of Appeals for the Seventh Circuit is in conflict with a decision or decisions of other Circuit Courts of Appeals on the same subject matter or adjudicating the validity of the same patents.

The rule is stated in General Talking Pictures Corporation v. Western Electric Company, Inc., et al., 304 U. S. 175, at 178 and 179, 58 S. Ct. 849, at 851, as follows:

"Nor would the writ be granted to review the questions of anticipation and invention that petitioner argues, for as to them there is no conflict between decisions of circuit courts of appeals." (Citing cases.)

In Magnum Import Company v. Coty, 262 U. S. 159, Mr. Chief Justice Taft said (163), in speaking of the exercise of the jurisdiction to bring up cases by certiorari:

". . . The jurisdiction was not conferred upon this court merely to give the defeated party in the circuit court of appeals another hearing."

3. There Is No Question of General Interest.

This is a suit between private persons involving patent infringement. The question is primarily one of fact. Questions of patentable invention are one of fact. Thomson Spot Welder Company v. Ford Motor Company, 265 U. S. 445, 44 S. Ct. 533, 68 L. Ed. 1098.

Writs of certiorari are not granted to review questions of anticipation and invention where there is no conflict (as here) between decisions of the circuit courts of appeals. General Talking Pictures Corporation v. Western Electric Company, 304 U. S. 175, 546, at 178 and 179, 58 S. Ct. 849 at 851.

4. The Use of the Flexible Membrane Was Old in the Art.

Petitioner makes the point in his brief that the Court of Appeals has overlooked the fact that these method claims include the use of a flexible membrane upon the surface of the tool.

The District Court in his opinion (R. 239) pointed out that original Claim 5 which included "means for preventing the adhesion of plastic material placed in the casing

to the plunger," was rejected by the Patent Office on Laskey No. 1,466,509 (R. 318 and R. 61), France No. 1,288,554 (R. 306 and R. 61), and Kruck No. 482,369 (R. 286 and R. 61). Applicant acquiesced in this rejection by cancelling the claim (R. 158 and R. 61).

The petitioner cannot now again urge that such cancelled element is a part of his method. Schriber-Schroth Co. v. Cleveland Trust Co., 311 U. S. 211, 61 S. Ct. 235; I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429, 443.

Hence, it is obvious that the Court of Appeals did not overlook such flexible membrane.

Further, the use of such a flexible membrane as pointed out in the action of the Patent Office of September 10, 1930 (R. 156-157, R. 61) is common practice and noninventive. The use of a waxed paper membrane was effectively ruled out of the claims as a new element and as being merely imitative by the Patent Office.

5. **The Method Claims Are Functional and Invalid.**

Stripped of all sophistry, these claims are merely directional of the use of the tool described in the patent.

The tool described in the patent (and in the rejected claims) consists merely of a casing wherein a plunger is slidably and controllably mounted therein for forcing plastic material therefrom onto a wall. The method claims, stripped of introductory clauses, recite the result or effect of using the tool, i. e., the quantity of plastic material so placed on the tool is pressed onto the wall to resemble stone.

The cases cited by petitioner in pages 14-18, inclusive, of his brief deal with processes that produce a new result or which may be performed by a machine as well as by hand. See quotation from Interstate Folding Box Co. v.

Empire Box Corporation, 68 F. (2d) 500, at 501 (C. C. A. 7, 1934), cited on page 14 of petitioner's brief, wherein he sets forth this sentence:

> " 'The act which is one of the successive steps of a valid process claim may be performed by a machine as well as by hand.' "

The inventor (petitioner herein) testified at the trial (R. 67 and 68):

> "I don't think that the process could be practiced by any other means without (the apparatus) unless it greatly resembled the description in these claims here. I would say (that the practicing of what was in the claims, as shown by the disclosure, is pretty well tied up with the apparatus described). No, (you could not practice this, what the patent teaches, by hand)." (Interpolations ours.)

All of the tools by which the method of the claims in suit could be practiced would have to be similar to the tool described in the patent. The inventor (petitioner) so stated at page 68 of the Record:

> "Q. Could you practice what your claims and disclosure teach by means other than the tool that you describe in it?
>
> A. A similar tool, yes.
>
> Q. But it would have to be similar; right?
>
> A. That is right."

The fact that petitioner has brought suit for infringement against these defendants alleging their practice of his method through similar tools is in itself a showing that he regards the tools as similar.

6. **The Corner Mold Patent Does Not Constitute Invention.**

Petitioner contends that since the applications (upon which these patents were granted) were copending, neither one could anticipate the other, and cites cases. However, each patent when issued must be for a *separate invention.* This is set forth by petitioner himself in quoting from Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co., 22 F. (2d) 259, at 260 (C. C. A. 2, 1927), at page 19 of his brief, wherein this appears at lines 4-7, inclusive, of the quotation from plaintiff's own brief:

> "The two applications were copending, and it is a matter of indifference which of the patents issued first, *provided that the claims are for separate inventions.*" (Our emphasis.)

The Court of Appeals held that there was no invention in the second patent and thus brings the rule squarely within the cases cited by petitioner.

Further, the court held that the second patent was nothing more than a solution of what any skilled workman, meeting this problem, having the old device before him, would have reached, without exercising any inventive genius.

The quotation taken by petitioner from defendant's brief, page 33, in the Court of Appeals, begs the question in that it includes the words "standing alone." But the second patent did not stand alone. It had to be inventive over the first patent, which it was not.

Thus it was pointed out in B. F. Sturtevant Co. v. Massachusetts Hair & Felt Co., 122 F. (2d) 900 (C. C. A. 1, 1941), cert. den. 62 S. Ct. 917, 315 U. S. 823, 86 L. Ed. 219, and cited by petitioner in his brief at pages 19 and 20, that claims to be allowable in a second or later patent must be

for a separate invention. As to what constitutes invention is a factual thing and at times the judgment of the court will appear, and no doubt be, to a large extent personal and in that sense arbitrary, as was further pointed out in that case at page 909 thereof.

7. **The Decision of the Circuit Court of Appeals Was Correct.**

This case presented a definite and undisputed fact situation to the Court below. The claims of the earlier method patent were informative of how to use the tool. The use of the tool involved the movement of its parts which was described in the method claims. Such method claims are clearly invalid and functional of the use of the tool.

The claims of the corner mold patent do not constitute invention. They do not involve more than what one skilled in the art would do, in the light of the state of the art at that time. That does not arise to the dignity of invention.

Regardless of anything that could be resolved on this petition, respondents are still entitled to a dismissal hereof on the finding of the District Court, undisturbed in the Circuit Court, that petitioner (plaintiff) was in court with unclean hands, and not presented for review in this Court.

Respondents are entitled to the relief which the Court awarded.

Respectfully submitted,

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